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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STANISLAV MALYSHEV, ZAC SPRACKETT, JELLE VINK,  
PAUL HUANG, and ARTEM VYSOTSKY

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Appeal 2019-000273  
Application 14/554,329  
Technology Center 2100

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Before JOSEPH L. DIXON, SCOTT B. HOWARD, and  
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–18. Appeal Br. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> Throughout this Decision, we use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42 (2017). Appellant identifies the real party in interest as SugarCRM, Inc. Appeal Br. 2.

## STATEMENT OF THE CASE

### *The Claimed Invention*

Appellant's invention relates generally to "[computer program] upgrade feasibility and reporting," and particularly to upgrade feasibility and reporting concerning "customized instance[s] of the computer program." Spec. ¶ 16.

Claim 1, reproduced below, is illustrative of the subject matter on appeal:

1. A method for application upgrade feasibility and reporting, the method comprising:

generating in memory of a computing system a deployment characterization of a customized instance of a computer program designated to receive an upgrade;

comparing the deployment characterization to a selection of known characterizations of deployment of different customized instances of the computer program, each of the known characterizations of deployment of different customized instances of the computer program having an association with an upgrade feasibility predictor for the upgrade;

identifying a matching one of the known characterizations for the generated deployment characterization; and,

displaying a report on a display of the computing system including an upgrade feasibility predictor corresponding to the matching one of the known characterization.

Appeal Br. 26 (Claims App.).

### *The Applied References*

The Examiner relies on the following references as evidence of unpatentability of the claims on appeal:

Nakagawa	US 5,835,911	Nov. 10, 1998
Mishra	US 7,127,707 B1	Oct. 24, 2006
Margulis	US 7,421,716 B1	Sept. 2, 2008

Winkler

US 2012/0174058 A1

July 5, 2012

*The Examiner's Rejections*

The Examiner made the following rejections of the claims on appeal:

Claims 1–18 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2–3.

Claims 1–3, 5, 7–9, 11, 13–15, and 17 stand rejected under 35 U.S.C. § 102(a)(1) as anticipated by Nakagawa. Final Act. 3–6.

Claims 4, 10, and 16 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Nakagawa, Winkler, and Margulis. Final Act. 6–7.

Claims 6, 12, and 18 stand rejected under 35 U.S.C. § 103 as unpatentable over the combination of Nakagawa and Mishra. Final Act. 7–8.

ANALYSIS<sup>2</sup>

*Section 101 Analysis*

Appellant disputes the Examiner's conclusion that claims 1–18 are directed to patent-ineligible subject matter. Appeal Br. 5–15; Reply Br. 2–5. Appellant argues these pending claims as a group. *See* Appeal Br. 15 (arguing together “claim 1, its counterpart independent claims and the respective dependencies”). Thus, for purposes of our analysis, we select independent claim 1 as the representative claim, and any claim not argued

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<sup>2</sup> Throughout this Decision, we have considered Appellant's Appeal Brief filed April 19, 2018 (“Appeal Br.”); Appellant's Reply Brief filed October 10, 2018 (“Reply Br.”); the Examiner's Answer mailed August 10, 2018 (“Ans.”); the Final Office Action mailed October 19, 2017 (“Final Act.”); and Appellant's Specification filed November 26, 2014 (“Spec.”).

separately will stand or fall with our analysis of the rejection of claim 1.  
*See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant argues the Examiner overgeneralized the claims, mischaracterized the alleged abstract idea, and failed to consider the recited limitations in determining whether the claims are patent eligible. Appeal Br. 5–10. In addition, Appellant asserts the claims use the alleged abstract idea in conjunction with a particular solution and provide an improvement to a technical field. Appeal Br. 10–15. Further, Appellant challenges the Examiner’s findings that the claims recite computer functions that are well-understood, routine, and conventional. Appeal Br. 12–16; Reply Br. 2–5. In the Answer, the Examiner maintains and further clarifies the Section 101 rejection. *See* Ans. 9–11.

“Whether a patent claim is drawn to patent-eligible subject matter is an issue of law that is reviewed de novo.” *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1331 (Fed. Cir. 2010).

The Supreme Court’s two-step framework guides our analysis of patent eligibility under 35 U.S.C. § 101. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). In addition, the Office recently published revised guidance for evaluating subject matter eligibility under 35 U.S.C. § 101, specifically with respect to applying the *Alice* framework. USPTO, 2019 *Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Office Guidance”). If a claim falls within one of the statutory categories of patent eligibility (i.e., a process, machine, manufacture, or composition of matter) then the first inquiry is whether the claim is directed to one of the judicially recognized exceptions (i.e., a law of nature, a natural phenomenon, or an abstract idea). *Alice*, 573 U.S. at 217. As part of this

inquiry, we must “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016). Per Office Guidance, this first inquiry has two prongs of analysis (i) does the claim recite a judicial exception (e.g., an abstract idea), and (ii) if so, is the judicial exception integrated into a practical application. 84 Fed. Reg. at 54. Under the Office Guidance, if the judicial exception is integrated into a practical application, *see infra*, the claim is patent eligible under § 101. 84 Fed. Reg. at 54–55. If the claim is directed to a judicial exception (i.e., recites a judicial exception and does not integrate the exception into a practical application), the next step is to determine whether any element, or combination of elements, amounts to significantly more than the judicial exception. *Alice*, 573 U.S. at 217; 84 Fed. Reg. at 56.

In this case, we conclude Appellant’s independent claim 1 recites an abstract idea because it recites mental processes. If a claim, under its broadest reasonable interpretation, covers performance in the mind but for the recitation of generic computer components, then it is still in the mental processes category unless the claim cannot practically be performed in the mind. *See Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1318 (Fed. Cir. 2016) (“[W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper.”); *see also CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011) (holding that the incidental use of a “computer” or “computer readable medium” does not make a claim otherwise directed to a

process that “can be performed in the human mind, or by a human using a pen and paper” patent eligible); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012) (explaining mental processes are not patentable); Office Guidance, 84 Fed. Reg. at 52–53 nn.14–15.

More specifically, Appellant’s claims are generally directed to reporting computer program upgrade feasibility. This is consistent with how Appellant describes the claimed invention. *See* Spec. ¶¶ 7 (describing the disclosed embodiments as systems and methods for “application upgrade feasibility and reporting”), 16 (“Embodiments of the invention provide for application upgrade feasibility and reporting.”), Abstract; *see also* Appeal Br. 8 (“Appellant[’s] claims pertain *to the concept of* ‘application upgrade feasibility and reporting’.” (emphasis added)), 13 (arguing independent claim 1 “achieve[s] the claimed concept of application upgrade feasibility and reporting”), 18 (“[A]s claimed, it is a comparison of different characterizations of different instances of the same computer program.” (citation omitted)). But for the recitation of a computing system memory and display, which we find to be generic computer components performing generic computing functions (as discussed further below; *see also, e.g.*, Spec. ¶¶ 27–33), reporting computer program upgrade feasibility is a series of observations, evaluations, judgments, and opinions that can be performed by a human, mentally or with pen and paper. *See, e.g.*, Spec. ¶ 20 (“Each predictor can be assigned statically by an administrator.”).

Consistent with our Office Guidance and case law, we conclude reporting computer program upgrade feasibility is a mental process and, thus, an abstract idea. *See* Office Guidance, 84 Fed. Reg. at 52; *see also Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*,

776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (explaining that claims drawn to data collection, recognition, and storage are “undisputedly well-known” and, absent more, are directed to an abstract idea); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (concluding that “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category”); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (concluding claims directed to “collecting and analyzing information to detect misuse and notifying a user when misuse is detected” to be mental processes within the abstract-idea category); *CyberSource*, 654 F.3d at 1371–72 (concluding claims directed to “detecting credit card fraud based on information relating [to] past transactions” can be performed in the human mind and were drawn to a patent-ineligible mental process).

Claim 1 is reproduced below and includes the following claim limitations that recite reporting computer program upgrade feasibility, emphasized in *italics*:

1. A method for application upgrade feasibility and reporting, the method comprising:

*generating in memory of a computing system a deployment characterization of a customized instance of a computer program designated to receive an upgrade;*

*comparing the deployment characterization to a selection of known characterizations of deployment of different customized instances of the computer program, each of the known characterizations of deployment of different customized instances of the computer program having an association with an upgrade feasibility predictor for the upgrade;*



*identifying a matching one of the known characterizations for the generated deployment characterization; and,*

displaying a report on a display of the computing system including an upgrade feasibility predictor corresponding to the matching one of the known characterization.

Appeal Br. 26 (Claims App.) (emphases added).

More particularly, reporting computer program upgrade feasibility comprises (i) collecting data to be analyzed (i.e., the claimed step of “generating” data, namely a deployment characterization of a customized instance of a computer program designated to receive an upgrade); and (ii) performing at least one operation on the collected data (i.e., the claimed step of “comparing” data, namely the deployment characterization, to other data, namely a selection of known characterizations of deployment of different customized instances of the computer program, where that data has “an association” with more data, namely an upgrade feasibility predictor for the upgrade; and the claimed step of “identifying” matching data, namely matching one of the known characterizations for the generated deployment characterization).

Because the claim recites a judicial exception, we next determine whether the claim integrates the judicial exception into a practical application. Office Guidance, 84 Fed. Reg. at 54. To determine whether the judicial exception is integrated into a practical application, we identify whether there are “*any additional elements recited in the claim beyond the judicial exception(s)*” and evaluate those elements to determine whether they integrate the judicial exception into a recognized practical application. Office Guidance, 84 Fed. Reg. at 54–55 (emphasis added); *see also* MPEP § 2106.05(a)–(c), (e)–(h).

In this case, we find the additional limitation(s) do not integrate the judicial exception into a practical application. More particularly, contrary to Appellant’s assertions (*see* Appeal Br. 10–15), the claims do not recite (i) an improvement to the functionality of a computer or other technology or technical field (*see* MPEP § 2106.05(a)); (ii) a “particular machine” to apply or use the judicial exception (*see* MPEP § 2106.05(b)); (iii) a particular transformation of an article to a different thing or state (*see* MPEP § 2106.05(c)); or (iv) any other meaningful limitation (*see* MPEP § 2106.05(e)). *See* 84 Fed. Reg. at 55.

Specifically, the additional limitation(s) merely describe using a computing system memory for “generating” or gathering data; and “displaying” data on a computing system display, where the displayed data is a “report” including an upgrade feasibility predictor. These steps are extra-solution activity of data gathering and displaying steps, which do not confer patent eligibility. *See, e.g., Elec. Power*, 830 F.3d at 1355 (explaining that “selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes”); *Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Can.*, 771 F. Supp. 2d 1054, 1066 (E.D. Mo. 2011), *aff’d*, 687 F.3d 1266 (Fed. Cir. 2012) (explaining that “storing, retrieving, and providing data . . . are inconsequential data gathering and insignificant post solution activity”). Further, the additional elements recited in independent claim 1 (e.g., a computing system environment using memory and a display) fail to convert the judicial exception into a patent-eligible application. *See Alice*, 573 U.S. at 223 (“Stating an abstract idea ‘while adding the words “apply it”’ is not enough for patent eligibility.”).

Contrary to Appellant’s assertions (*see, e.g.*, Appeal Br. 10–15), independent claim 1 does not recite an improvement to the functionality of a computer or other technology or technical field. *See* MPEP § 2106.05(a). As the court in *Enfish* explained, “the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). Although Appellant repeatedly characterizes the claimed invention as providing an “improvement to computer-related technology” (*see, e.g.*, Appeal Br. 11 (emphases omitted)), Appellant does not sufficiently identify the specific *technological* computer “problem” being solved or the specific *technological* computer “improvement.” *See* Appeal Br. 10–15. Indeed, claim 1 uses “a computing system” to perform four steps—generate data in memory, compare data, identify matches in data, and display reports of data on a display—without further limitation acting to improve upon such method steps.

Appellant argues that the recitation in claim 1 of a “customized” instance of a computer program, as opposed to any other instance of a computer program, allegedly improves the claimed process for reporting computer program upgrade feasibility (Appeal Br. 11–12); however, the “customized” instance of a computer program in claim 1 relates merely to the data being generated, compared, identified, and displayed, and does not improve a computer, technology, or a technical field. *See McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016) (“We . . . look to whether the claims in these patents focus on a specific

means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” (citing *Enfish*, 822 F.3d at 1336)). Here, unlike in *McRO* and *Enfish*, we find the invention of claim 1 merely uses computer devices *as tools*, rather than improving upon those tools.

For at least the foregoing reasons, independent claim 1 does not integrate the judicial exception into a practical application.

Because we determine the invention of independent claim 1 is directed to an abstract idea or combination of abstract ideas, we analyze the claim under step two of *Alice* (i.e., step 2B of the Office Guidance) to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 72–73, 77–79). As stated in the Office Guidance, many of the considerations to determine whether the claims amount to “significantly more” under step two of the *Alice* framework are already considered as part of determining whether the judicial exception has been integrated into a practical application. 84 Fed. Reg. at 56. Thus, at this point of our analysis, we determine if the claims add a specific limitation, or combination of limitations, that is not well-understood, routine, conventional activity in the field, or simply append well-understood, routine, conventional activities at a high level of generality. 84 Fed. Reg. at 56. “Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.” *Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018).

In this case, Appellant’s claim 1 does not recite specific limitations (alone or when considered as an ordered combination) that are not well-understood, routine, and conventional. Instead, when describing its system for reporting computer program upgrade feasibility, Appellant describes the system and components at a high level of generality and notes that the system may be provided by one or “any suitable combination” of many various computer readable storage devices (Spec. ¶¶ 27–28); by many various networking components, like “the Internet, a local area network, a wide area network and/or a wireless network” (Spec. ¶ 29); and by many various “computer readable program instructions [that] may be provided to a processor of a general purpose computer, special purpose computer, or other programmable data processing apparatus to produce a machine” (Spec. ¶ 32). *See also* Spec. Figs. 1–2 (showing system at a high level of generality). As the Examiner finds (*see* Final Act. 2–3 (citing case law); Ans. 10–11), the recited components and functions, such as generating, comparing, and displaying data, as well as comparing deployment characterizations to known characterizations, are “basic function[s],” i.e., well-understood, routine, and conventional features. Consistent with the *Berkheimer* Memorandum,<sup>3</sup> we agree with the Examiner’s findings that the

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<sup>3</sup> On April 19, 2018, the Deputy Commissioner for Patent Examination Policy issued a memorandum entitled: Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*) (i.e., “the *Berkheimer* Memorandum”) (discussing the *Berkheimer* decision) (available at <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF>). Support for a finding that an element was well-understood, routine, or conventional may be shown by citation to one or more court decisions noting the well-

claims merely recite generic computer components (e.g., a computing device comprising a processor and memory) performing generic computing functions that are well-understood, routine, and conventional (e.g., receiving or generating data, processing and comparing data, and presenting the results of the data processing). *See Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016) (generic computer components, such as an “interface,” “network,” and “database,” fail to satisfy the inventive concept requirement); *Alice*, 573 U.S. at 226 (“Nearly every computer will include a ‘communications controller’ and [a] ‘data storage unit’ capable of performing the basic calculation, storage, and transmission functions required by the method claims.”); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“That a computer receives and sends the information over a network—with no further specification—is not even arguably inventive.”).

Furthermore, contrary to Appellant’s conclusory assertions (*see, e.g.*, Appeal Br. 10–15), we find no additional limitations in independent claim 1 that amount to “significantly more” than the abstract idea. For example, in claim 1, there is no additional limitation that informs “how” the “generating” step “generat[es] . . . a deployment characterization of a customized instance of a computer program designated to receive an upgrade,” or informs “how” generating data such as a characterization for a “customized” instance of a computer program requires significantly more than generating data for any other instance of a computer program. The same holds true for claim 1’s

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understood, routine, conventional nature of the element(s). *See Berkheimer* Memorandum 3–4.

“comparing,” “identifying,” and “displaying” steps (alone or when considered as an ordered combination).

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly, we sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 101. Further, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of claims 2–18, which were not argued separately. *See* 37 C.F.R. § 41.37(c)(1)(iv).

### *Section 102 – Anticipation*

Appellant disputes the Examiner’s findings that Nakagawa anticipates claims 1–3, 5, 7–9, 11, 13–15, and 17. Appeal Br. 16–23; Reply Br. 6–8. Appellant argues these appealed claims as a group. *See* Appeal Br. 16–23. Thus, for purposes of our analysis, we select independent claim 1 as the representative claim, and any claim not argued separately will stand or fall with our analysis of the rejection of claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv). We turn to the teachings of Nakagawa.

Nakagawa relates generally to “a software distribution and maintenance system and method with which a software vendor can provide a number of users with software over a network, and update and maintain the software at requests of the users.” Nakagawa 1:12–18. Nakagawa explains that “[s]oftware vendors and server programs in vendor computers should properly recognize” “various software environments in user computers,” and that “variation pertaining to a number of software affects the distribution and management of the software.” *Id.* at 4:31–44. According to Nakagawa:

A number of sets of software may be systematically distributed and maintained via a network connecting many vendors and users of client/server software. A client program in a user

computer detects when software subject to maintenance is activated and transmits an inquiry over the network to the software vendor's computer for information on the current version of the software. The server program compares data in the inquiry with data relating to the latest version of the software and returns update instruction information and updated software if appropriate. The client program automatically updates the software to the latest version according to the update instruction information when it is received.

*Id.*, Abstract.

Nakagawa discloses its system addresses “*configurations and versions of an object software*” (*id.* at 13:32–34 (emphases added)), and explains:

Since a single set of software Si has a number of version *types* depending on the type of computer, *the specification of functions*, etc., the version types are specified by respective characters such as Si.V, Si.V', Si.V", etc. Furthermore, *each version type is qualified with a version number* for management of update order. For example, Si.V.1 indicates the version type and number of a set of software. The set of version type and number are referred to as a version for short.

*Id.* at 13:35–57 (emphases added). “When *users* adopt object software Si, *they normally desire to select the optimum version type Si.V from among a number of version types* and then use the latest version Si.V.1 in the selected type.” *Id.* at 13:58–61 (emphases added). Nakagawa also discloses “[t]he object software Si is supplied by a vendor (Vk) and managed in the software library SLi which stores software of all versions . . . of all version types.” *Id.* at 13:45–49. In updating software, Nakagawa discloses “the server program SP compares the [software configuration] information with the configuration of the software library SL, and returns the instruction information for updating software Si of user A together with the updated



software.” *Id.* at 29:65–30:5; *see also id.* at 29:13–55 (explaining that software versions comprise variously selected modules).

To serve as an anticipatory reference, “the reference must disclose each and every element of the claimed invention, whether it does so explicitly or inherently.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (citation omitted). The Examiner finds Nakagawa anticipates claim 1, and as relevant here, the limitation of “comparing the deployment characterization to a selection of known characterizations of deployment of different customized instances of the computer program, each of the known characterizations of deployment of different customized instances of the computer program having an association with an upgrade feasibility predictor for the upgrade” (hereinafter “Comparing Limitation”). Ans. 12–13. In particular, the Examiner acknowledges Appellant’s proffered claim construction for “customize,” namely “to build, fit, or alter according to individual specifications” (Appeal Br. 21–22; *see* Ans. 13), and finds:

Nakagawa teaches . . . comparing the current configuration to a selection of latest version’s configurations of different versions of the software stored in a library, each of the configurations of different versions of the software having an association with an upgrade feasibility predictor, such as update, added functions, added modules. . . . Nakagawa teaches different versions of a software are stored in [a] vendor computer’s library, *wherein each of [the] different versions compris[es] different modules to build, fit[,] or alter according to each of [the] different versions of the software. Therefore, each of different versions of the software is interpreted as a customized instance of a computer program.*

Ans. 12–13 (emphases added; citations omitted).

Appellant argues that “customized” in the Comparing Limitation renders claim 1 patentable over Nakagawa. Appeal Br. 17; Reply Br. 6. In particular, Appellant argues:

Nakagawa refers to a comparison of a known required configuration of a target to an actual configuration of a target. However, Appellant’s claims require more. Appellant is specifically solving the problem of application upgrade feasibility and reporting regarding customized instances of a computer program. Appellant’s invention would be rendered inoperable if Appellant’s invention were to employ the disclosure of Nakagawa as “the indiscriminate upgrading of a customized deployment of a computer program oftentimes can “break” the deployment resulting in a costly rolling back of the upgrade.”

Appeal Br. 20. We find Appellant’s arguments unpersuasive of Examiner error for at least the following reasons (and those set forth by the Examiner as discussed above).

First, Appellant hinges patentability here on the presence of the term “customized” in characterizing the “computer program” in *method* claim 1. But claim 1 recites “customized” without any additional context, such as, for example, customized “by whom,” “when,” or “relative to what.” Even accepting Appellant’s definition of “customize” as “to build, fit, or alter according to individual specifications” (*see supra*), we find Appellant does not show persuasively that “a customized instance of a computer program” *as recited in claim 1* excludes “alter[ed]” or different versions of computer programs, as found by the Examiner (Ans. 12–13). *See, e.g., E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (Claims must be interpreted “‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.” (citing *Texas Digital Sys.*,

*Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1203–04 (Fed. Cir. 2002))); Reply Br. 7–8.

Second, claim 1 is a *method* claim with four *steps*, namely generating, comparing, identifying, and displaying certain data. Appellant does not show persuasively how “customized,” as recited, for example, in the Comparing Limitation, is functionally related to the “comparing” step (or to the “generating” step). Indeed, Appellant does not show persuasively how any characteristic of “comparing” or “generating” *as recited in claim 1* is changed by a “customized” computer program versus, for example, an altered or different computer program. As a general proposition, we need not give patentable weight to *non-functional* descriptive material absent a new and nonobvious functional relationship between the descriptive material and the substrate. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *see also King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010); Manual of Patent Examining Procedure (MPEP) § 2111.05 (9th ed. Rev. 08.2017, Jan. 2018). In *Ex parte Nehls*, 88 USPQ2d 1883, 1888 (BPAI 2008) (precedential), the Board held that the nature of the information being manipulated by the computer should not be given patentable weight absent evidence that the information is functionally related to the process “by changing the efficiency or accuracy or any other characteristic” of the steps. *See also Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (holding “wellness-related” data stored in a database and communicated over a network was non-functional descriptive material as claimed because the data “does not functionally change” the system).

Third, although Appellant argues “Nakagawa refers to a comparison of a known required configuration of a target to an actual configuration of a

target” and submits “Appellant’s claims require more” (Appeal Br. 20; *see* Reply Br. 7), Appellant does not show persuasively how so. For example, Appellant does not sufficiently explain why an “actual” configuration of a computer program excludes “customized,” “altered,” or “different” configurations of a computer program. Moreover, claim 1 does compare a deployment characterization of a “customized” (or “actual”) instance of a computer program to “known” configurations, and “match[es]” the “customized” configuration to such “known” configurations. Given this comparison and matching to “known” configurations, we find Appellant does not show persuasively why a “customized” configuration as recited in claim 1 excludes “known” configurations (i.e., if A matches to B, and B is known, then A is known).

Fourth, Appellant’s argument (Appeal Br. 20) that its invention would be rendered inoperable if it employed the disclosure of Nakagawa lacks merit. Appellant argues “the indiscriminate upgrading of a customized deployment of a computer program oftentimes can ‘break’ the deployment resulting in a costly rolling back of the upgrade” (Appeal Br. 20), but the invention recited in method claim 1 does not perform any upgrading (only generating, comparing, identifying, and displaying certain data). *See Vas–Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991) (“The invention is . . . whatever is now claimed.”).

Finally, in Appellant’s Reply Brief, Appellant belatedly asserts:

Appellant[’s] upgrade feasibility predictors associated with customized instances of a computer program, as defined in the Appellant[’s] originally filed specification, are not the same as Nakagawa’s single determination of whether a known update is required for a known version of an application.

Reply Br. 8. This argument (which Appellant asserts the Examiner allegedly “fail[ed] to address” (*id.*)) was not made in the Appeal Brief, but could have been, and is not responsive to any new evidence or finding set forth by the Examiner in the Answer. In the absence of a showing of good cause by Appellant, these arguments are untimely and deemed waived.

Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the [E]xaminer’s answer, including any designated new ground of rejection, will not be considered by the Board for purposes of the present appeal, unless good cause is shown.

37 C.F.R. § 41.41(b)(2); *see also Ex parte Nakashima*, 93 USPQ2d 1834, 1837 (BPAI 2010) (informative) (explaining that arguments and evidence not presented timely in the principal brief will not be considered when filed in a reply brief, absent a showing of good cause explaining why the argument could not have been presented in the principal brief); *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner’s rejections, but were not.”).

Notwithstanding the tardiness of such argument, we do not find it persuasive. The Examiner finds “each of the configurations of different versions of the software hav[e] an association with an upgrade feasibility predictor, such as update, added functions, added modules.” Ans. 12 (citing Nakagawa, col. 29, lines 13–36); *see* Final Act. 3–4. Other than mere conclusory attorney argument asserting the Comparing Limitation “is lacking in Nakagawa” (Appeal Br. 17) and is “not the same as” Nakagawa (Reply Br. 8 (belated argument quoted above)), Appellant does not substantively evidence error in the Examiner’s finding here. It is well settled

that mere attorney arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (attorney argument is not evidence).

Based on the foregoing, we find Appellant does not show persuasively that the Examiner erred in finding independent claim 1 anticipated by Nakagawa.

Accordingly, we sustain the Examiner's rejection under 35 U.S.C. § 102(a)(1) of independent claim 1. For similar reasons, we sustain the Examiner's rejection under 35 U.S.C. § 102(a)(1) of independent claims 7 and 13, and claims 2, 3, 5, 8, 9, 11, 14, 15, and 17 which depend therefrom, none of which were argued separately. *See* 37 C.F.R. § 41.37(c)(1)(iv).

### *Section 103 – Obviousness*

Appellant disputes the Examiner's findings that the combination of Nakagawa, Winkler, and Margulis renders obvious claims 4, 10, and 16, and that the combination of Nakagawa and Mishra renders obvious claims 6, 12, and 18. Appeal Br. 23–25. Appellant argues these dependent claims as a group, and relies upon the arguments for patentability of independent claim 1 (*see* Appeal Br. 23–25), which we find unpersuasive as discussed above.

Appellant submits no other argument in the Appeal Brief as to the non-obviousness of these dependent claims, but for its conclusory assertion that “the Examiner fails to provide any rationale or reasoning as to why one would combine the cited references and why those support a conclusion of obviousness.” Appeal Br. 24. To support the legal conclusion of

obviousness, “there must be some articulated reasoning with some rational underpinning” for combining elements in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Additionally, “[m]otivation to combine may be found in many different places and forms.” *Allergan, Inc. v. Sandoz Inc.*, 726 F.3d 1286, 1292 (Fed. Cir. 2013); *see also Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1294 (Fed. Cir. 2006) (stating that the motivation to combine does not have to be explicitly stated in the prior art).

Contrary to Appellant’s assertion, (1) in the Final Action as to claims 4, 10, and 16, the Examiner identifies additional teachings in Winkler and Margulis, and finds it would have been obvious “to have combined *Windkler’s [sic] teaching* and Nakagawa’s teaching to include modified components in the composite application, *since the combination would have allowed the user to modify components in the composite application as Windkler disclosed,*” and “to have combined *Margulis’ teaching* and Nakagawa’s teaching to include components that have been modified from a default form of the components, *since the combination would have facilitate[d] the redeploying when a component is changed/modified as Margulis disclosed*” (Final Act. 6–7 (emphases added)); and (2) in the Final Action as to claims 6, 12, and 18, the Examiner identifies additional teachings in Mishra, and finds it would have been obvious “to have combined *Mishra’s teaching* and Nakagawa’s teaching to include a hyperlinked reference to crowd-sourced documentation . . . , *since the combination would have provided guidance resources/help[] associated with upgrade issues as Mishra disclosed*” (Final Act. 8 (emphases added)). The Examiner essentially repeats these findings in the Answer. *See*

Ans. 14–15. In view of the foregoing, Appellant’s mere assertion that the Examiner “fails to provide any rationale or reasoning” for the obviousness rejections at issue lacks merit and is unpersuasive of Examiner error.

Appellant chose not to address these findings by the Examiner in its Appeal Brief, so we deem any argument as to these findings in its Reply Brief to be waived. *See* 37 C.F.R. § 41.41(b)(2) (discussed above).

Based on the foregoing, we find Appellant does not show persuasively that the Examiner erred in concluding claims 4, 10, and 16 obvious over the combination of Nakagawa, Winkler, and Margulis, or erred in concluding claims 6, 12, and 18 obvious over the combination of Nakagawa and Mishra.

Accordingly, we sustain the Examiner’s rejection under 35 U.S.C. § 103 of dependent claims 4, 6, 10, 12, 16, and 18, which were argued as a group. *See* 37 C.F.R. § 41.37(c)(1)(iv).

## DECISION SUMMARY

In summary:

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–18	101	Eligibility	1–18	
1–3, 5, 7–9, 11, 13–15, 17	102(a)(1)	Nakagawa	1–3, 5, 7– 9, 11, 13– 15, 17	
4, 10, 16	103	Nakagawa, Winkler, Margulis	4, 10, 16	
6, 12, 18	103	Nakagawa, Mishra	6, 12, 18	
<b>Overall Outcome</b>			1–18	



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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

*See* 37 C.F.R. § 41.50(f).

AFFIRMED